No. 06-

IN THE

Supreme Court of the United States

JAMES P. LOGAN, JR.,

Petitioner,

v.

HORMEL FOODS, INC. and WAL-MART, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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May 23, 2007

QUESTION PRESENTED

A patent includes two fundamental elements, the specification and the claims. The specification describes how to practice the invention and includes various embodiments of the invention so that persons skilled in the art are enabled to use the invention. The claims, on the other hand, define the scope of the invention, are the things evaluated against the prior art when determining whether an invention is "novel," and are the measure of whether future devices or methods infringe upon the patent. Claims can and typically do exceed the scope of the particular embodiments in the specification, which are simply examples of the invention.

Claim construction is the first of two steps in a patent infringement suit. It requires the court to determine, as matter of law, the meaning and the scope of the patent. *Anchor Wall Sys., Inc. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1306 (Fed.Cir.2003). In considering a summary judgment motion the court is to resolve any doubts and draw any inferences in favor of the nonmoving party. *Evans v. City of Houston*, 246 F.3d 344, 348 (5th Cir.2001). The questions presented by this Petition are:

Whether the Federal Circuit erred by affirming summary judgment when the Federal Circuit's construction of the claim term "support member," which was substantially different from the District Court's construction?

Whether the Federal Circuit improperly discounted the non-moving party's evidence in deference to evidence of an experimental process different from the process actually used to produce the product accused of infringing appellant's patent?

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HORMEL FOODS, INC., and
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On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

Petitioner James P. Logan, Jr., respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The initial order of the district court construing the relevant terms of the patent claim and granting summary judgment for the defendant is unpublished and is reproduced herein as Appendix B. The decision of the Federal Circuit affirming summary judgment is unpublished and is reproduced herein as Appendix A. The Federal Circuit's denial of rehearing is unpublished and is reproduced herein as Appendix C.

JURISDICTION

The Federal Circuit issued its opinion on January 25, 2007 and denied rehearing on February 22, 2007. This Court has jurisdiction to hear this Petition pursuant to 28 U.S.C. § 1254(1).

RELEVANT STATUTORY PROVISIONS

An order granting summary judgment is only proper when

> "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law."

Fed. R. Civ. P. 56(c).

STATEMENT OF THE CASE[1]

Petitioner James P. Logan, Jr. is the holder of U.S. Patent No. Re. 35,374 ("the '374 patent"). The '374 patent, titled "Spirally Sliced Boneless Meat Product," is a reissue of U.S. Patent No. 5,030,472. Petitioner filed this suit in May of 2004 in the United States District Court for the Eastern District of Texas. In this case plaintiff accuses defendants Hormel Food Corp. and Wal-Mart Stores, Inc. of infringing the '374 patent by manufacturing, selling, or offering to sell Hormel's CURE 81 boneless, spiral-sliced hams.

The '374 patent describes a boneless, spirally-sliced meat product and an apparatus and method for spirally slicing the same. Claim 1, the only independent claim at issue on this appeal, recites as follows:

> "1. A boneless sliced meat having its meat arranged in the form of a continuous spiral cut about an axis of the meat, the axis being created by temporary insertion of a

[1] Unless otherwise noted, the facts are taken from the Federal Circuit opinion, attached hereto as Appendix A, and from the district court's opinion, attached hereto as Appendix B.

support member in the meat, wherein the depth of said cut is limited to leave an uncut core of meat, said core being of sufficient cross-section to cause the boneless sliced meat to retain its shape when the support member is removed." (*emphasis added*)

Respondents' accused product is a boneless, spiral sliced ham made by the process of impaling the ham with a prong (either 2 3/8" or 1" in length) fixed to the axis of rotation of a lower chuck assembly. The meat is then rotated via the rotary table and prong. A blade is then introduced into the meat short of the rotational axis of the meat and then indexed linearly along this axis to create a spiral slice about a central, uncut core of meat. Respondents' accused hams are approximately 8" in length and the ham was spirally sliced to within approximately 1" of each end.

The language "support member in the meat" was the only language in dispute. The parties submitted respective combined *Markman* briefs and summary judgment motions on the issue of infringement. Petitioner moved for summary judgment of infringement under another district court's interpretation in a prior case ("spit or pointed rod inserted in the meat"). Respondents moved for summary judgment of non-infringement under its proffered interpretation ("a spit (or pointed rod) that traverses the entire length of the spiral cut and helps the boneless meat maintain its shape or integrity during slicing operations") because Respondents' product was not made by a process whereby the prong did not traverse the entire length of the spiral cut or help the boneless meat maintain its shape or integrity during slicing operations.

The district court adopted Respondents' construction and granted summary judgment of non-infringement. The district court reasoned that because Respondents' products were made by impaling the hams with a prong which were either 1" or 2 3/8" in length, there was no literal infringement because said prongs failed to traverse the entire length of the

spiral cut. Furthermore, the district court determined that summary judgment of non-infringement under the doctrine of equivalents was appropriate because Hormel's prong did not perform the function of helping the boneless meat maintain its shape or integrity during slicing operations. To support this determination the district court relied upon evidence of an isolated experiment whereby Hormel was successful in spirally slicing a ham on Hormel's slicing machines without the use of a prong of spit. The district court concluded that because a ham was capable of being sliced on Hormel's machine without the use of a prong or spit as shown in the isolated experiment, then the prong or spit actually used to manufacture the accused hams must not "help the boneless meat maintain its shape or integrity during slicing operations." The district court further held that Logan offered no evidence to contradict an experiment conducted by Hormel showing that a ham could be spirally sliced without the use of a prong or spit and thus the prong used by Hormel did not support the boneless meat during slicing operations.

In January of 2006, Logan appealed the district court's claim construction and grant of summary judgment of non-infringement. The Federal Circuit rejected the district court's construction of "support member" with respect to the requisite length of insertion of the "support member (or spit)", i.e., must traverse the entire length of the spiral cut; and rendered a proper construction of this language whereby the "support member (or spit)" must be inserted "in the meat far enough to 'support' the meat during slicing."

Although the Federal Circuit found that the district court had erred in construing the term "support member in the meat", the Federal Circuit concluded the error was harmless. The Federal Circuit stated that Logan failed to point to any evidence that Hormel's 1" or 2 3/8" prong used to make its CURE 81(R) boneless hams "help the boneless meat maintain its shape or integrity during slicing," as required by

claim 1. In addition, the district court noted, Logan provided no evidence to contradict Hormel's evidence that its prong did not perform this function because the meat could have been made without the use of a prong. Therefore, the Federal Circuit affirmed the district court's judgment that the Hormel CURE 81(R) hams did not infringe claim 1 of the'374 patent either literally or under the doctrine of equivalents.

Logan petitioned for rehearing, which was denied on February 22, 2007. App. C. This petition for certiorari followed.

REASON FOR GRANTING THE WRIT

This petition raises for this Court's consideration an issue of critical importance to the fair and uniform administration of Federal Rules of Civil Procedure and pre-trial procedure, specifically as relates to patent actions in district courts throughout the country and in the Federal Circuit.

Based upon the Federal Circuit's rejection of the district court's construction of "support member" and its rendering of a proper construction, a genuine issue of material fact is raised and this case should be remanded to the District Court to give the fact finder the opportunity to determine whether Defendant Hormel's device includes the requisite "support member" as construed by the Federal Circuit. This case has focused primarily on whether defendant's prong in its device satisfies the "support member" element of the claim. The district dourt construed the term as having a requisite length (traverse the entire length of the spiral cut). The Federal Circuit found that such a limitation was improper and that the proper construction required insertion only "in the meat."

Although the Panel found that the District Court's construction of the term was erroneous, the Federal Circuit found that the error was harmless and concluded that the there was no genuine issue of material fact raised as to infringement by Defendants' device. The Federal Circuit concluded that Logan failed to point to any evidence that the

Defendants' prong used to make its Cure 81® boneless hams "help the boneless meat maintain its shape or integrity during slicing". The Federal Circuit did not address the arguments made Logan.

Under the Federal Circuit's reasoning there could never be any infringement of claim 1 of the patent no matter the size, shape or length of penetration of the spit so long as the meat were capable of being spirally-sliced without spit at all. This is because of the Federal Circuit's faulty reasoning that evidence that a boneless meat product can be made without a spit, prong or "support member" establishes that the use of a spit, prong or "support member" of any type must not "help the boneless meat maintain its shape or integrity during slicing." Such a conclusion is clearly illogical.

I. A Genuine Issue of Material Fact has been Raised as to Whether the Hormel Prong Helps to Maintain the Shape or Integrity of the Boneless Meat during Slicing.

In this petition for rehearing, Logan would respectfully show the court that evidence was identified that would satisfy this construed element of the claim, or at the very least raise a genuine issue of material fact requiring this case to be remanded to the District Court for further proceedings based upon the new claim construction. "Summary judgment is appropriate if, drawing all factual inferences in favor of the non-movant, there is no genuine issue of material fact and the movant is entitled to judgment as a matter of law". [emphasis added] *Scanner Technologies Corp. v. ICOS Vision Systems Corp.*, 365 F.3d 1299, 1302 (Fed. Cir. 2004); Fed. R. Civ. P. 56(c). The alleged facts must be viewed in the light most favorable to Logan. *Id.*

As construed by the court, the "support member" element must help, or in other words contribute, to the boneless meat maintaining its shape or integrity during slicing. In its brief, and in the record below, Logan pointed to the declaration by

a Hormel witness in support of the argument that Hormel's prong does help during the slicing of the meat. [See pgs. 9-10 of Logan's Grey Brief]. In particular, Hormel's witness specifically stated that the prong centers the boneless meat and holds or grips the boneless meat on the lower spindle during slicing. [See A853 ¶ 5; A855 ¶ 13]. Once the boneless ham is impaled upon the spit the ham can have no other rotational axis because the spit prevents lateral movement of the ham. [See A540 ¶ 1]. It is evident that centering the meat and holding the meat during slicing the prong contributes or helps in maintaining the integrity and shape of the meat. The centered position and maintaining that position is necessary for the meat to maintain its shape and integrity. Indeed, if the meat is not centered or it moves during the slicing it will lose its shape and it will lose its integrity. This evidence shows that a genuine dispute over a material fact exists. Therefore the Federal Circuit was incorrect in granting summary judgment to Hormel based on the evidence presented.

In addition, the experiment conducted by Hormel did not address whether the Hormel prong (either the 2 3/8" or the 1"), when used, helped in maintaining the shape or integrity of the meat. Moreover, the Declaration of Brian E. Hendrickson ("the Hendrickson Declaration) relied on by Hormel also does not address whether the Hormel prong helps or contributes to the boneless meat maintaining its shape or integrity during slicing. The Hendrickson Declaration concluded that the "prong used by Hormel to center and grip the meat on the lower spindle does not support the core of the meat while slicing". A855-56. This conclusion does not address the Panel's claim construction of "support member" and is more restrictive than the Panel's construction of the term "support member".

Furthermore, the Hendrickson Declaration does not address the prong having a length of 2 3/8 inches in his experiment. [See A855, ¶'s 11-13, no experiment or

conclusion was made with respect to the 2 3/8 inch prong]. Mr. Hendrickson does not address the 2 3/8 inch prong with respect to its role in helping to maintain the shape or integrity of the boneless meat during slicing. Therefore reliance on his conclusion at least to the 2 3/8 inch prong and his experiment was improper.

Nevertheless, the experiment where the prong was removed merely changed the accused product from a meat product made with the use of a prong or spit to a meat product made without. Had Hormel made its boneless, spiral-sliced hams without the use of a spit or support member in the meat (as shown in the experiment), then they would not infringe Claim 1 of the patent. However, Hormel's experiment of spiral slicing without a prong or spit does not address the contribution made by the Hormel prong either in a 1" or 2 3/8" configuration during the normal operations of the accused Hormel products. Indeed, although Hormel did slice a ham without the prong, Hormel admits that it has used and continues to use a prong in its normal operations. Therefore, the prong which penetrates the meat serves a function in successfully slicing a ham that maintains its shape and integrity.

Moreover, the conclusions drawn by Hormel and the Court based on the Hendrickson experiment would contradict Hendrickson's Declaration. In the Hendrickson Declaration, Mr. Hendrickson declared that the prong on the lower spindle centers the boneless meat and holds or grips the meat on the spindle during slicing. [See A853 ¶ 5; A855 ¶ 13]. When the prong was removed in the experiment, the boneless meat in that single experimental use apparently remained centered and on the spindle during slicing. Therefore, based on Hormel's fallacious reasoning one must conclude that the prong does not center or hold or grip the meat on the spindle. Yet it is undisputed that the prong does center and hold or grip the meat on the lower spindle.

Furthermore, Hormel's reasoning would also lead to a similar erroneous conclusion with respect to a prong that traversed the entire length of the boneless meat. Under Hormel's reasoning the prong that traversed the entire length of the meat would serve no purpose because the meat could in one instance in a single experiment be cut without it. Logan's and indeed the Panel's infringement analysis should focus on the device the Hormel is actually using and did use and not on a device that Hormel chose not to use.

The evidence shows that Hormel operates a cutting device that has a prong because it serves a significant purpose in successfully slicing a piece of boneless. That Hormel may remove the prong and still slice the meat does not take away from the fact that the prong when used contributes or helps the boneless meat in maintaining its shape and integrity during slicing. As construed by this Court, the claim does not require that the prong or "support member" to be the single factor in the meat maintaining its shape or integrity. The claim only requires that the "support member" help in the boneless meat maintaining its shape or integrity.

Under the Federal Circuit's rationale, Hormel would never infringe claim 1 of the patent even if it had used an enormous, barbed spit that was inserted entirely through the ham because Hormel's isolated experiment showed that it is sometimes possible to spirally slice a boneless ham without the insertion of such a "support member." The Federal Circuit's reliance upon this experiment to conclude that what the prong must and must not do is illogical.

Summary judgment evidence must be viewed in a light most favorable to Logan. It is undisputed that the Hormel prong serves a function in producing a sliced boneless meat that maintains its shape and integrity. That function includes keeping the boneless meat centered and on the spindle. If the meat is not maintained in this centered position then it will not have a centered uniform core and therefore will not

maintain its shape and integrity. If Hormel had made its boneless, spiral-sliced meat products accused of infringing the patent according to its isolated experiment then Hormel would clearly not infringe claim 1. However, Hormel did in fact make the accused products with a "support member"—not without one.

It was error for the Federal Circuit to determine that Logan failed to meet their summary judgment burden when there was evidence to confirm a genuine issue of a material fact does exist. Because this case illustrates a fundamental problem with the Federal Court's non-uniform application of the Federal rules created and upheld by this Court, it is an excellent vehicle for this Court to employ in reaching this important question.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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Dated: May 23, 2007

APPENDIX

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DATED JANUARY 25, 2007

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

No. 2006-1114

JAMES P. LOGAN, JR.,

Plaintiff-Appellant,

and

LOGAN FARMS, INC.,

Plaintiff,

v.

HORMEL FOODS, INC.,

Defendant-Appellee,

and

WAL-MART, INC.,

Defendant-Appellee.

Jan. 25, 2007

Rehearing Denied Feb. 22, 2007

Before LOURIE, LINN, and MOORE, *Circuit Judges*.

Appendix A

MOORE, *Circuit Judge.*

James P. Logan, Jr. ("Logan") appeals the final judgment of the United States District Court for the Southern District of Texas granting summary judgment in favor of defendants Hormel Foods, Incorporated and Wal-Mart, Incorporated (collectively "Hormel"). *Logan v. Hormel Foods, Inc.*, No. 4:05-CV-00055, 2005 WL 2171893 (S.D.Tex. Sept. 2, 2005). While the district court erred in its claim construction, we conclude the error was harmless and that summary judgment of non-infringement of United States Patent No. Re 35,374 ("the '374 patent") was proper even under the correct claim construction. Therefore, we *affirm.*

I. BACKGROUND

Logan filed suit against Hormel alleging that Hormel's CURE 81® boneless, spiral-sliced hams infringe claim 1 of the '374 patent. The '374 patent describes a spirally-sliced meat product and the apparatus and method for spirally slicing the meat. Claim 1, the only independent claim at issue on this appeal, recites as follows:

> A boneless sliced meat having its meat arranged in the form of a continuous spiral cut about an axis of the meat, the axis being created by temporary insertion of a *support member in the meat,* wherein the depth of said cut is limited to leave an uncut core of meat, said core being of sufficient cross-section to cause the boneless sliced meat to retain its shape when the support member is removed.

'374 patent, col. 10, ll.4-10 (emphasis added).

The district court construed the term "support member" to mean "a spit (or pointed rod) that traverses the length of the spiral cut and helps the boneless meat maintain its shape or integrity during slicing operations." *Logan,* 2005 WL 2171893 at *6. The district court granted summary judgment on the issue of literal infringement because Hormel's CURE 81® hams were made by impaling them on a prong which was either 13 or 2 3/83 in length,[1] and therefore did not traverse the length of the spiral cut. *Id.* at *7-8. Furthermore, the district court determined that summary judgment of non-infringement under the doctrine of equivalents was appropriate because Hormel's prong did not perform the function of helping the boneless meat maintain its shape or integrity during slicing operations. *Id.* at *8. The district court found that Logan offered no evidence to contradict an experiment conducted by Hormel showing that the prong did not support the boneless meat during slicing operations. *Id.*

On appeal, Logan challenges the district court's claim construction and grant of summary judgment of non-infringement. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

II. DISCUSSION

A. Claim Construction

We agree with the portion of the district court's claim construction that requires that the support member "help[ ] the boneless meat maintain its shape or integrity during

1. Hormel changed the length of its spit after Logan instituted the present litigation.

slicing operations," however, the intrinsic record does not require the "support member" to "traverse the length of the spiral cut," so long as it is performing the function of helping "the boneless meat maintain its shape or integrity during slicing operations."

Logan argues that the "support member" should only be required to hold the meat. Logan cites numerous dictionary definitions in an attempt to bolster his argument. However, these dictionary definitions are inconsistent with the intrinsic record and therefore, are not probative. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1322-23 (Fed.Cir.2005) (en banc) (stating that courts may rely "on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents."). The '374 patent uses the term "hold" in reference to the chuck assembly, which includes a number of short spikes to help hold the meat. *See, e.g.*, '374 patent, col.3, ll.53-57 ("The apparatus includes an electrically driven, rotating meat chuck assembly for holding the meat . . . during cutting operations"); *id.*, col.4, ll.1-2 ("The chuck assembly is designed to hold and rotate the meat during cutting operations."). The specification indicates that the support member does more than "hold" the boneless meat-it provides support for the meat. *See id.*, col.5, ll.61-64 ("The meat spit 400 is used in the slicing of boneless meats to provide support by inserting the stem member 404 into the meat during slicing operations.").

The prosecution history also supports this construction. During prosecution, Logan informed the Patent and Trademark Office that the support member "provides the

boneless meat product with sufficient structural stability during the slicing operation" and that the spit "maintain[ed] meat integrity during the slicing operation." Moreover, during prosecution, Logan submitted videotaped experiments to establish that a particular reference was not enabled. These experiments are part of the intrinsic record, are properly considered in construing the claims, and further support this construction. Thus, we conclude that the support member "helps the boneless meat maintain its shape or integrity during slicing operations."

We do not agree, however, that the support member must "traverse the length of the spiral cut" as the district court required. Logan argues that Hormel's 13 and 2 3/83 prongs are "in the meat." Hormel argues that the support member must extend into the meat so as to traverse the length of the spiral cut. We conclude that the claim language "in the meat" does not require that the support member extend through the entire meat product nor does it require the support member traverse the entire spiral cut portion. Nothing in the specification or prosecution history requires this narrow construction.

Claim 1 requires only that the support member be "in the meat." '374 patent, col.10, ll.6-7. Other claims require that the "support member [be] inserted *through* the annular core [of meat] prior to slicing. . . ." *Id.*, at col. 10, ll.13-14 (claim 2) (emphasis added); *see also id.*, at col.10, ll.27-28 (claim 4), col.11, ll.7-8 (claim 10). Hence, while claims 2, 4, and 10 require the support member be inserted through the meat, claim 1 in contrast only requires that the support member be in the meat. Because the patentee used different

terminology in different claims, there is a presumption that there is a difference in the scope of the claims. *See Forest Labs., Inc. v. Abbott Labs.*, 239 F.3d 1292, 1310 (Fed.Cir.2001) (citing *Tandon Corp. v. United States Int'l Trade Comm'n,* 831 F.2d 1017, 1023 (Fed.Cir.1987)). We conclude that "in the meat" must be read in conjunction with "support member" and that therefore the claim requires that the support member be in the meat far enough to "support" the meat during slicing (i.e., to maintain its shape or integrity during slicing).

While the specification discloses only a single embodiment, the intrinsic record does not limit the scope of the term "support member" to the only disclosed embodiment. *See Phillips,* 415 F.3d at 1323 ("[W]e have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment."). Thus, it is improper to read the sole embodiment from the specification into claim 1 and require that the support member extend through the meat. We also do not believe that the support member must extend the length of the spiral cut because while the claim requires the support member to define an "axis" of the meat, there is no reason why a support member that does not traverse the length of the spiral cut cannot define such an axis.

We conclude that the support member must extend into the meat to a sufficient length to support the meat during cutting (to help the meat maintain its shape or integrity during slicing), but not necessarily extend through the meat or traverse the entire length of the spiral cut.

Appendix A

B. Infringement

While the district court erred in construing the term "support member in the meat," that error was harmless. Logan fails to point to any evidence that Hormel's 13 or 2 3/83 prong used to make its CURE 81® boneless hams "help [ ] the boneless meat maintain its shape or integrity during slicing," as required by claim 1. Moreover, as the district court noted, Logan provided no evidence to contradict Hormel's evidence that its prongs do not perform this function. We find the remainder of Logan's arguments regarding infringement to be without merit. Therefore, we affirm the district court's judgment that the Hormel CURE 81® hams do not infringe claim 1 of the '374 patent either literally or under the doctrine of equivalents.

No costs.

APPENDIX B — MEMORANDUM OPINION AND ORDER OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF TEXAS, HOUSTON DIVISION DATED SEPTEMBER 2, 2005

UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION

No. Civ.A. H-05-00[illegible]

JAMES P. LOGAN, JR. and LOGAN FARMS INC.,

Plaintiffs,

v.

HORMEL FOODS INC. and WAL-MART INC.,

Defendants.

Sept. 2, 2005

MEMORANDUM OPINION AND ORDER

LAKE, J.

Plaintiff, James P. Logan, Jr., brings this action against defendants, Hormel Foods Inc. and Wal-Mart Inc., for infringement of U.S. Patent No. Re. 35,374, dilution/injury to trade reputation, unfair competition, and tortious interference with contract/business relations. Pending before the court are: (1) Defendants' Opening Markman Brief (Docket Entry No. 42), (2) Plaintiff's Combined *Markman* Brief and Motion for Partial Summary Judgment of Patent

Infringement (Docket Entry No. 44), and (3) Defendants' Cross-Motion for Summary Judgment on Infringement (Docket Entry No. 49). For the reasons discussed below, and in conjunction with the court's construction of disputed claim terms, plaintiff's motion for partial summary judgment will be denied and defendants' cross-motion for summary judgment will be granted.

I. *Factual and Procedural Background*

Plaintiff James P. Logan, Jr. is the holder of U.S. Patent No. Re. 35,374 ("the '374 patent"). The '374 patent, titled "Spirally Sliced Boneless Meat Product," is a reissue of U.S. Patent No. 5,030,472. In this case plaintiff accuses defendants Hormel Food Corp. and Wal-Mart Stores, Inc. of infringing the '374 patent by manufacturing, selling, or offering to sell Hormel's CURE 81 boneless, spiral-sliced hams. Plaintiff indicates he will not pursue the other claims for dilution/injury to business reputation, unfair competition, and tortious interference with contract/business relations.[1]

The '374 patent discloses a meat product and a method for making that product. Claim 1 is the only claim (out of ten) that plaintiff asserts against defendants. It describes a

> boneless sliced meat having its meat arranged in the form of a continuous spiral cut about an axis of the meat, the axis being created by the

1. See Letter from Robert M. Bowick to David Mayberry and Lee L. Kaplan (May 20, 2005), Tab 1, Appendix of Materials in Support of Defendants' Opening Markman Brief ("Defendants' Appendix I"), Docket Entry No. 46.

> temporary insertion of a support member in the meat, *wherein the depth of said cut is limited to leave an uncut core of meat, said core being of sufficient cross-section to cause the boneless sliced meat to retain its shape when the support member is removed.*

'374 patent, col. 10, lines 4-10 (emphasis original). The patent teaches a process in which a support member, or spit, is inserted through a boneless piece of meat; the meat is then mounted in a slicing apparatus and held in place by chuck assemblies that contain protruding spikes and receive the ends of the spit; an electrical motor and drive shaft connected to one of the chucks rotates the meat about the axis created by the spit; a slicer blade is introduced into the meat in a plane substantially perpendicular to the meat's rotational axis; and the blade is indexed linearly along an axis parallel to the meat's rotational axis to create the spiral cut. '374 patent, abstract; cols. 3-4. After slicing is complete the meat is removed from the apparatus and the support member from the meat. '374 patent, abstract. Because the slicer blade is limited to cutting within 1/8 of an inch of the meat spit, an uncut core of meat remains and functions to maintain the meat's shape. '374 patent, col. 4, lines 47-51; col. 10, lines 4-10.

According to the affidavit of Hormel's Brian E. Hendrickson, a product manufacturing manager, Hormel produces its CURE 81 hams—which are spiral—sliced and contain an uncut core—with machines that "mount[ ] and grip[ ] the boneless meat product at both its opposing ends and drive[ ] those ends simultaneously and uniformly" during

slicing operations.[2] Prior to November 22, 2004, Hormel's machines included an "approximately two and three eighths (2 3/8) inch prong on the lower spindle to center the boneless meat and hold the meat on the lower spindle during slicing."[3] Hormel subsequently replaced the 2-3/8 inch "prongs" with "prongs that are approximately one (1) inch long."[4] Neither prong is long enough to traverse the length of the spiral cut, and the shorter one does not extend to where the cut begins.[5]

Plaintiff filed this suit along with co-plaintiff Logan Farms, Inc. in May of 2004 in the United States District Court for the Eastern District of Texas.[6] After transfer to this court,[7] Logan Farms, Inc. was dismissed as a party plaintiff pursuant to plaintiff's unopposed motion.[8] The remaining parties have submitted briefs proposing constructions of certain terms in

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2. Affidavit of Brian E. Hendrickson at ¶¶ 2-3, 10, Tab 2, Appendix of Materials in Support of Defendants' Combined Reply to Plaintiff's Markman Brief, Opposition to Motion for Summary Judgment, and Memorandum in Support of Cross-Motion for Summary Judgment ("Defendants' Appendix II"), Docket Entry No. 51.

3. *Id.* at ¶ 5.

4. *Id.* at ¶ 6.

5. See *id.* at ¶ 6; Exhibits 10-11 attached to Plaintiff's Memorandum in Support of Its Combined *Markman* Brief and Motion for Partial Summary Judgment of Patent Infringement, Docket Entry No. 47.

6. See Plaintiff's Original Complaint, Docket Entry No. 1.

7. See Memorandum Opinion and Order Transferring Venue to the Southern District of Texas (Aug. 25, 2004), Docket Entry No. 25.

8. See Order (June 3, 2005), Docket Entry No. 48.

the claim at issue. They generally agree with Judge Ewing Werlein, Jr.'s construction of the claim terms in a previous infringement case brought by plaintiff against other defendants.[9] *See Logan Farms, Inc., et al. v. Honey Baked Ham L.P., MI, et al.*, H-01-1611. The parties differ, however, over the construction of "support member" and what Judge Werlein meant when he construed this term to mean "spit." The parties have also filed motions for summary judgment.

II. *Claim Construction*

A. Standard of Review

Claim construction is the first of two steps in a patent infringement suit. It requires the court to determine, as a matter of law, the meaning and scope of the patent claims. *Anchor Wall Sys., Inc. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1306 (Fed.Cir.2003) (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-71 (Fed.Cir.1995) (*en banc*), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996)). According to *Markman v. Westview Instruments, Inc.*, claim construction is the court's "power and obligation" in a jury case. 52 F.3d at 979. The court's construction permits the jury in the second step of the suit to decide the fact question of infringement, which requires a comparison of properly construed patent claims and the alleged infringer's device or process. *See Anchor Wall Sys., Inc.*, 340 F.3d at 1306.

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9. See Plaintiff's Proposed Findings of Fact and Conclusions of Law, Docket Entry No. 52; [Proposed] Findings of Fact and Conclusions of Law, attached to Defendants' Opening Markman Brief, Docket Entry No. 42.

Appendix B

In construing claims the court should consider first intrinsic evidence of the record: the patent itself, including the claims, the specification, and, if in evidence, the prosecution history. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996). This is the "most significant source of the legally operative meaning of disputed claim language." *Id.* When analysis of the intrinsic evidence permits unambiguous definition of the meaning and scope of the claims, as it will in most cases, reference to extrinsic evidence is improper. *Id.* at 1583. The Federal Circuit has recently reaffirmed this principle in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed.Cir.2005): Although courts can put general or specialized dictionaries and comparable extrinsic sources to "appropriate use" in helping to ascertain the commonly understood meaning of words, they must give this evidence only the relatively limited weight it is due and not divorce claim terms from the context of the intrinsic evidence. *See id.* at 1318-19, 1322-24.

A court's examination of the intrinsic evidence in a claim construction analysis begins with the words of the disputed claim itself. *Vitronics Corp.*, 90 F.3d at 1582. The claims define the scope of the right to exclude. *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1324 (Fed.Cir.2002) (quoting *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248 (Fed.Cir.1998). In the absence of a patentee's "express intent to impart a novel meaning to the claim terms," the words of the claims take on the " 'ordinary and customary meanings attributed to them by those of ordinary skill in the art.' " *Mars, Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1373 (Fed.Cir.2004) (quoting *Int'l Rectifier Corp. v. IXYS Corp.*, 361 F.3d 1363, 1369 (Fed.Cir.2004); *Brookhill-Wilk 1, LLC*

v. Intuitive Surgical, Inc., 334 F.3d 1294, 1298 (Fed.Cir.2003)).

In assessing the meaning of the claim terms a court must always review the specification. *Vitronics*, 90 F.3d at 1582. The specification is the part of the patent that "teaches" the invention so that one skilled in the art can make and use it. *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1335 (Fed.Cir.2003). The specification is "highly relevant" to claim construction because it may contain special or novel definitions of claim terms when the patentee has chosen to be his own lexicographer, *Vitronics*, 90 F.3d at 1582, or it may help to resolve ambiguity when the ordinary and customary meaning of a term is not sufficiently clear, *Teleflex, Inc.*, 299 F.3d at 1525. The specification might also contain a "clear disavowal of claim scope" through "expressions of manifest exclusion or restriction." *Teleflex, Inc.*, 299 F.3d at 1325. It may aid in determining whether the patentee "has disclaimed subject matter or has otherwise limited the scope of the claims." *Anchor Wall Sys.*, 340 F.3d at 1306. In sum, the specification is the " 'single best guide to the meaning of a disputed term,' " *Phillips*, 415 F.3d at 1321 (quoting *Vitronics*, 90 F.3d at 1582), and is usually "dispositive." *Vitronics*, 90 F.3d at 1582.

A court must be prudent, however, in narrowing claim terms based on the specification. The Federal Circuit has instructed that "limitations may not be read into the claims from the written description" and that mere inclusion in the specification of drawings depicting a "particular embodiment of the patent does not operate to limit the claims to that specific configuration." *Anchor Wall Sys.*, 340 F.3d at 1306-

07. There is "sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification," but nevertheless, the court is to do the former and avoid the latter. *Comark Communications Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed.Cir.1998)). "To avoid importing limitations from the specification into the claims, it is important to keep in mind" the purpose of the specification and to try to decide whether the patentee is teaching the invention by "setting out specific examples" or whether he instead "intends for the claims and the embodiments in the specification to be strictly coextensive." *Phillips*, 415 F.3d at 1323.

The final source of intrinsic evidence plays a role similar to the specification in the claim construction analysis. The prosecution history of the patent—the complete record of the proceedings before the Patent and Trademark Office—"provides evidence of how the PTO and the inventor understood the patent" and should be considered by the court, if in evidence. *Id.* at 1317. "The patent applicant's consistent usage of a term in prosecuting the patent may enlighten the meaning of that term." *Metabolite Laboratories, Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1360 (Fed.Cir.2004). The prosecution history may contain "express representations made by the applicant regarding the scope of the claims." *Vitronics Corp.*, 90 F.3d at 1582. But any limitation found in the history must be "clear and unmistakable." *Anchor Wall Sys.*, 340 F.3d at 1307.

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B. Construction of Claim 1

In defendants' view the only term in claim 1 of the '374 patent that remains at issue is "support member"—the object that is temporarily inserted in the meat that creates the axis about which the spiral is cut.[10] See '374 patent, claim 1, col. 10, lines 4-10. Defendants urge the following construction: (1) "support" means "to keep the uncut core of meat from failing in order to maintain the continuous spiral cut about the axis of the meat," and (2) "support member" is a "single structure" that provides this support and that "extends at least the length of the continuous spiral cut."[11] Defendants argue that this proposed construction is consistent with "spit," the term the parties recognize as Judge Werlein's construction of "support member" in the earlier case.[12] Plaintiff accepts Judge Werlein's construction of the claim terms—including

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10. Defendants' Opening Markman Brief, Docket Entry No. 42, p. 2.

11. *Id.* at 17-18.

12. *Id.* at 10-11. See also Plaintiff's Memorandum in Support of Its Combined *Markman* Brief and Motion for Partial Summary Judgment of Patent Infringement, Docket Entry No. 47, p. 9. It appears that "support member" was not directly at issue in the '374 patent case before Judge Werlein. He did not enter an explicit construction of "support member" in his memorandum and order construing other terms of the '374 patent claims. Judge Werlein did, however, use the word "spit" in apparent reference to "support member" throughout his construction of those other claim terms. See Defendants' Opening Markman Brief, Docket Entry No. 42, pp. 10-11; Memorandum and Order (Sept. 4, 2003), *Logan Farms, Inc., et al. v. Honey Baked Ham, L.P., MI, et al.*, H-01-1611, Tab 3, Defendants' Appendix I, Docket Entry No. 46.

"support member" as "spit"—but urges the court, if anything, to define "spit" as a "pointed rod" or "pointed rod for holding meat" and to construct "in the meat" as "into the meat" (as opposed to "through the meat").[13] Plaintiff resists any construction of "support member" indicating a "specific type, style or size of spit."[14]

The court begins by construing "support member" as "spit." This is consistent with both parties' arguments and their view of Judge Werlein's earlier construction of "support member."[15] Further, the parties appear to agree that spit is a "pointed rod."[16] Their dispute, and the court's focus, centers on whether the "support member" mentioned in claim 1 should be further construed with additional limitations based on its function.

The claim language supports defendants' argument that the '374 patent requires a "support member" or "spit" that traverses the length of the spiral cut. The claim states that

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13. Plaintiff's Memorandum in Support of Its Combined *Markman* Brief and Motion for Partial Summary Judgment of Patent Infringement, Docket Entry No. 47, pp. 6-15.

14. See *id.* at 13.

15. See *supra* notes 12-13 and accompanying text.

16. See Plaintiff's Memorandum in Support of Its Combined *Markman* Brief and Motion for Partial Summary Judgment of Patent Infringement, Docket Entry No. 47, pp. 11-13 (quoting dictionary definitions of "spit"); Defendants' Combined Brief in Reply to Plaintiff's Markman Brief, in Opposition to Plaintiff's Motion for Summary Judgment, and in Support of Their Cross-Motion for Summary Judgment, Docket Entry No. 50, pp. 4-5.

the uncut core of meat must be of sufficient cross-section to permit the meat to retain its shape *when* the support member is removed. '374 patent, claim 1, col. 10, lines 4-10. If the support member were shorter than the length of the spiral cut, the uncut core would have to be sufficient to provide for the meat's integrity *during* slicing operations as well as after, when the spit is removed. Otherwise, the meat would lose its shape as the slicer blade passed beyond the reach of the short spit, not just when the support member was removed. But claim 1 mentions nothing about maintaining the meat's shape prior to spit removal. Thus, the court concludes that the claim language contemplates a spit extending the length of the cut—a spit that, while it remains inserted, supports the meat's shape regardless of the cross-section of the uncut core.

In responding to defendants' argument that "support member" contains a length limitation, plaintiff offers dictionary definitions suggesting "support" is synonymous with "hold."[17] His theory, as the court interprets it, is that "support member" need not be read to serve the function of providing structural support to the entire length of uncut core

17. Plaintiff's Response to Defendants' Cross-Motion for Summary Judgment of Non-Infringement, Docket Entry No. 55, p. 7.

18. See *id.* Plaintiff also suggests that "support member" need not be limited in accordance with any particular function: "The function of the structure of the claimed invention is of no consequence, unless the claim is written in 'means-plus' language pursuant to 35 U.S.C. § 112, ¶ 6." *Id.* at 7-8. This unelaborated and unsupported assertion is without merit. To the extent the claim term serves a particular function as identified by the patent, that function is relevant to a proper construction of that term. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1324-27 (Fed.Cir.2005).

and therefore need not be limited to any minimum length.[18] The '374 patent's specification, however, appears to distinguish "support" and "hold." As plaintiff himself notes, the summary and written description refers to a "meat spit" inserted in the boneless product that is "designed to provide structural support for the meat during boneless cutting operations."[19] '374 patent, col. 4, lines 5-7. See also '374 patent, col. 3, lines 63-65; col. 5, lines 61-64.

Moreover, it is the "chuck assembly," not the support member, that is "designed to hold and rotate the meat during cutting operations." '374 patent, col. 4, lines 1-2. The written description indicates that the meat is "held" by "the plurality of spikes" located on the faces of the upper and lower chucks. '374 patent, col. 9, lines 38-40.

The court is persuaded that the patent's repeated association of "spit" with "structural support" on the one hand, and "chuck assembly" and "spikes" with "hold" on the other, indicates a special role for "support member" beyond merely holding the meat. In other words, the difference in diction suggests "support member" cannot be just another spike, or even an elongated one, and indeed the written description discloses a spit that travels completely through the boneless meat product. '374 patent, col. 6, lines 1-3. Thus, the specification is entirely consistent with the court's initial reading of "support member" as a spit extending the length of the spiral cut that serves the particular function of helping the boneless meat maintain its shape.

19. See Plaintiff's Memorandum in Support of Its Combined *Markman* Brief and Motion for Partial Summary Judgment of Patent Infringement, Docket Entry No. 47, pp. 12-13.

Appendix B

The prosecution history confirms that "support member" should be construed along the lines of the court's interpretation of the claim language. During reexamination of his patent plaintiff "submitted videotaped evidence of the inoperability" of an abandoned prior patent application and "the patentably distinct product produced by [him] using the patentably distinct method."[20] The court has viewed this tape.[21] It depicts a series of attempts to spirally-slice boneless meat products. In three of those attempts no spit was used. Each time, regardless of the radius of uncut core—which was as great as two inches—the spit-less meat broke apart during slicing.[22] Plaintiff explained to the examiner that "the rotational force imparted on one end of the meat product . . . caused rotational stresses in the solid core of meat that caused the meat product to twist apart" despite the solid central core.[23] The core simply "lacked the necessary stability and physical integrity to prevent the [meat] from twisting apart."[24] As plaintiff stated, his "unique method" included a "spit through the center axis" that "provides the boneless meat product with sufficient structural stability during the slicing

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20. Response to Office Action Dated Sept. 10, 1992, at pp. 1-2, Tab 4, Defendants' Appendix I, Docket Entry No. 46.

21. Defendants have included a copy of the videotape at Tab 15, Defendants' Appendix I, Docket Entry No. 46.

22. Response to Office Action Dated Sept. 10, 1992, at p. 2, Tab 4, Defendants' Appendix I, Docket Entry No. 46.

23. *Id.*

24. Declaration of James P. Logan, attached to Response to Office Action Dated Sept. 10, 1992, Tab 4, Defendants' Appendix I, Docket Entry No. 46.

operation."[25] With the spit traversing the product, the meat did not twist apart in the final experiment on the videotape. Given this context it is clear that "support member" envisions a structure that helps the meat remain whole during slicing operations.

Although it does not appear that plaintiff expressly stated in the prosecution history that the "support member" or spit must traverse the length of the spiral cut, the court is persuaded that no other conclusion is reasonable. Like the specification, plaintiff's videotaped demonstration of his "unique method" disclosed a spit extending through the boneless meat product. There is no hint that the benefit provided by the support member component—which, according to any fair assessment of plaintiff's argument during reexamination, was an important part of his "patentably distinct method"[26]—could be obtained with a shorter spit, much less with one that does not even traverse the length of the spiral cut. Moreover, plaintiff's representations before the examiner, like his claim language,

25. Response to Office Action Dated Sept. 10, 1992, at p. 3, Tab 4, Defendants' Appendix I, Docket Entry No. 46.

26. Without it, plaintiff's method would be as inoperable as the three failed experiments depicted in the videotape. Plaintiff insists that he did not distinguish his invention from the prior art on the basis of any particular length spit. See Plaintiff's Memorandum in Support of Its Combined *Markman* Brief and Motion for Partial Summary Judgment of Patent Infringement, Docket Entry No. 47, pp. 13-14; Plaintiff's Response to Defendants' Cross-Motion for Summary Judgment of Non-Infringement, Docket Entry No. 55, pp. 8-9. However, the contrast between his method and the failed experiments indicates that a spit of at least some minimum length is a necessary part of the claimed invention.

suggest a support member or spit that is coextensive with the spiral cut. In his summary of the videotape segment depicting his method, plaintiff indicated that "[a]fter the boneless meat product has been sliced and the spit removed, the remaining solid central core of meat provides the spiral sliced boneless meat product with structural integrity. . . ."[27]

As the court's review of the intrinsic evidence indicates, the court concludes that defendants' proposed limitation of "support member" (incorporating their construction of "support") is correct. Accordingly, the court adopts the following construction of "support member": a spit (or pointed rod) that traverses the length of the spiral cut and helps the boneless meat product maintain its shape or integrity during slicing operations.

As noted above, plaintiff argues that "in the meat" should be read as "into the meat," not "through the meat."[28] The court declines to adopt this construction. According to the court's reading of the '374 patent's claim 1, the spit may or may not extend completely through the meat. The claim language "in the meat" is consistent with either length spit.[29]

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27. Response to Office Action Dated Sept. 10, 1992, at p. 3, Tab 4, Defendants' Appendix I, Docket Entry No. 46.

28. See *supra* note 13 and accompanying text.

29. Plaintiff argues that the "principles of claim differentiation" compel the adoption "into the meat" for "in the meat," because other claims in the '374 patent require spits that are inserted "through the meat." Plaintiff's Memorandum in Support of Its Combi ıed *Markman* Brief and Motion for Partial Summary Judgment of Patent Infringement, Docket Entry No. 47, p. 14. The court notes its construction of claim 1 does not require the spit to traverse the entire cut of meat but merely the length of the spiral cut.

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The remainder of claim 1's terms are construed in accordance with Judge Werlein's earlier construction, as set forth by the parties in their *Markman* briefs.[30]

III. *Infringement*

A. Standard of Review

An order granting summary judgment is proper when "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(c). A "genuine" dispute over a fact exists if "the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 106 S.Ct. 2505, 2510, 91 L.Ed.2d 202 (1986). A fact is "material" if it "might affect the outcome of the suit under the governing law." *Id.* In considering a summary judgment motion the court is to resolve any doubts and draw any inferences in favor of the nonmoving party. *Evans v. City of Houston*, 246 F.3d 344, 348 (5th Cir.2001).

Summary judgment may be granted, upon motion and after an adequate period for discovery, against a party who has failed to make a sufficient showing establishing the existence of an element essential to the party's case and as to which the party bears the burden of proof. *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548, 2552, 91 L.Ed.2d 265 (1986). The party moving for summary judgment has

30. See *id.* at 7; Defendants' Opening Markman Brief, Docket Entry No. 42, p. 10.

the "initial responsibility of informing the district court of the basis for its motion" and "identifying those portions of [the record], which it believes demonstrate the absence of a genuine issue of material fact." *Id.* at 2553. If this burden is met the nonmoving party must respond by going outside the pleadings and pointing to facts that indicate a "genuine issue for trial." *Little v. Liquid Air Corp.*, 37 F.3d 1069, 1075 (5th Cir.1994). The nonmoving party must do more than rest on " 'some metaphysical doubt,' " " 'conclusory allegations,' " " 'unsubstantiated assertions,' " or a mere " 'scintilla' " of evidence. *Id.* at 1075 (quoting *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 106 S.Ct. 1348, 1356, 89 L.Ed.2d 538 (1986); *Lujan v. Nat'l Wildlife Fed'n*, 497 U.S. 871, 110 S.Ct. 3177, 3180, 111 L.Ed.2d 695 (1990); *Hopper v. Frank*, 16 F.3d 92 (5th Cir.1994); *Davis v. Chevron USA, Inc.*, 14 F.3d 1082 (5th Cir.1994)). Instead, the party opposing summary judgment must respond by "tendering depositions, affidavits, and other competent evidence," *Topalian v. Ehrman*, 954 F.2d 1125, 1131 (5th Cir.1992).

B. Literal Infringement

Plaintiff and defendants each move for summary judgment as to literal infringement. Relying in part on his construction of "support member," plaintiff argues that the boneless, spiral-sliced hams manufactured by defendant Hormel and sold by defendant Wal-Mart literally infringe claim 1 of the '374 patent.[31] Defendants contend they are

31. Plaintiff's Memorandum in Support of Its Combined *Markman* Brief and Motion for Partial Summary Judgment of Patent Infringement, Docket Entry No. 47, pp. 17-22.

entitled to summary judgment of non-infringement because, among other things, the "lower prongs" on its machines are not "support members."[32]

Having construed the claim term "support member" as a spit extending through the length of the spiral cut, the court concludes that defendants' product does not literally infringe claim 1 of the '374 patent. "[A]n accused product literally infringes if every limitation recited in the claim appears in the accused product." *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 1382 (Fed.Cir.2000). The evidence is clear that contrary to the express requirement of claim one, the axis about which the meat in defendants' product is arranged was not created by the temporary insertion of a "support member"—a spit traversing the length of the spiral cut that helps the meat maintain its integrity during slicing. See '374 patent, col. 10, lines 4-10. The spit on defendants' machine is too short to qualify as a "support member" contemplated by the '374 patent.

The parties agree that the process defendant Hormel used to spiral-slice the accused product—at least prior to the week beginning November 22, 2004—is depicted by video footage contained on a CD included with plaintiff's brief supporting his motion for partial summary judgment.[33] The court has

32. Defendants' Combined Brief in Reply to Plaintiff's Markman Brief, in Opposition to Plaintiff's Motion for Summary Judgment, and in Support of Their Cross-Motion for Summary Judgment, Docket Entry No. 50, pp. 11-17.

33. See Plaintiff's Memorandum in Support of Its Combined *Markman* Brief and Motion for Partial Summary Judgment of Patent

(Cont'd)

reviewed this footage. It is consistent with defendants' representation (supported by the affidavit of a Hormel Product Manufacturing Manager) that the spiral-slicing machines used by Hormel contain a spit—defendants call it a "prong"—on the "lower spindle" that is 2-3/8 inches long.[34] It does not appear to the court that this spit traverses the entire length of the spiral cut—or perhaps even half.[35]

C. Equivalents

Defendants also move for summary judgment that the accused product does not infringe the '374 patent under the doctrine of equivalents.[36] Plaintiff opposes summary judgment because defendants do not deny some length

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(Cont'd)

Infringement, Docket Entry No. 47, pp. 18-22; Defendants' Combined Brief in Reply to Plaintiff's Markman Brief, in Opposition to Plaintiff's Motion for Summary Judgment, and in Support of Their Cross-Motion for Summary Judgment, Docket Entry No. 50, p. 11.

34. Defendants' Combined Brief in Reply to Plaintiff's Markman Brief, in Opposition to Plaintiff's Motion for Summary Judgment, and in Support of Their Cross-Motion for Summary Judgment, Docket Entry No. 50, p. 11 (citing Affidavit of Brian E. Hendrickson, at ¶¶ 4-5, Tab 2, Defendants' Appendix II, Docket Entry No. 51).

35. See Exhibits 10-11 attached to Plaintiff's Memorandum in Support of Its Combined *Markman* Brief and Motion for Partial Summary Judgment of Patent Infringement, Docket Entry No. 47.

36. Defendants' Combined Brief in Reply to Plaintiff's Markman Brief, in Opposition to Plaintiff's Motion for Summary Judgment, and in Support of Their Cross-Motion for Summary Judgment, Docket Entry No. 50, pp. 17-19.

" 'prong' or other pointed rod" must be used and that defendants cannot show their " 'prong(s)' do not perform substantially the same function, in substantially the same way, to achieve substantially the same result as the 'support member' or 'spit' of the claimed invention."[37] Plaintiff asserts that "[t]he culmination of evidence of the parties [sic] respective *Markman* briefs and motions for summary judgment clearly evidence at least a question of fact as to whether Defendants' 'prong(s)' satisfy one of these three inquiries."[38]

According to the doctrine of equivalents, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 117 S.Ct. 1040, 1045, 137 L.Ed.2d 146 (1997). Elements are equivalent if they perform "substantially the same function in substantially the same way to obtain substantially the same result." *See Anchor Wall Sys., Inc.*, 340 F.3d at 1313. *See also Warner-Jenkinson Co.*, 117 S.Ct. at 1054. The doctrine of equivalents "must be applied to individual elements of the claim, not to the invention as a whole"; the doctrine must not be "allowed such broad play as to effectively eliminate [an] element in its entirety." *Warner-Jenkinson Co.*, 117 S.Ct. at 1049. Accordingly, there is infringement under the doctrine of equivalents only if the

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37. Plaintiff's Response to Defendants' Cross-Motion for Summary Judgment of Non-Infringement, Docket Entry No. 55, p. 10.

38. *Id.*

accused product or process contains elements identical or equivalent to each claimed element of the patented invention. *See id.* at 1054.

Defendants' 2-3/8-inch spit does not perform "substantially the same function in substantially the same way to obtain substantially the same result" as claim 1's "support member." As the court has construed it, the "support member" used to create the axis, see '374 patent, col. 10, lines 4-10, is a spit that helps the meat maintain its integrity during slicing operations. Defendants' short spit apparently does not perform this function. Referencing the affidavit of the Hormel product manufacturing manager, defendants describe a videotaped experiment in which a ham was sliced on a Hormel machine with *no* prong on the lower spindle.[39] The "meat was spirally sliced from top to bottom without twisting or breaking."[40] According to the Hormel manager, the "dual-drive design" of Hormel's machines—the machines "mount[ ] and grip [ ]" the boneless meat at both ends and drive the ends "simultaneously and uniformly"—"reduces torque on the boneless meat, preventing the central core from twisting apart and breaking."[41]

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39. Defendants' Combined Brief in Reply to Plaintiff's Markman Brief, in Opposition to Plaintiff's Motion for Summary Judgment, and in Support of Their Cross-Motion for Summary Judgment, Docket Entry No. 50, pp. 12-14 (citing Affidavit of Brian E. Hendrickson, at ¶¶ 11-13, Tab 2, Defendants' Appendix II, Docket Entry No. 51).

40. *Id.* at 13.

41. Affidavit of Brian E. Hendrickson at ¶ 10, Tab 2, Defendants' Appendix II, Docket Entry No. 51.

Plaintiff neither cites his own evidence controverting the validity of this experiment nor explains how a fact question of equivalence remains despite the experiment's findings. Instead, plaintiff appears to ignore or overlook that defendants actually do deny that any prong or pointed rod is necessary for their product. Plaintiff has not met his summary judgment burden.

D. Defendants' New Product

In their brief supporting the cross-motion for summary judgment, defendants indicate that Hormel replaced the 2-3/8-inch spits on the meat slicing machines with prongs slightly less than an inch long in November of 2004.[42] As a result, defendants state that the slicing blade begins the spiral cut above the bottom prong—the one-inch spit does not penetrate the uncut core of meat at the center of the spiral cut.[43] The court has focused its analysis on the product created with the 2-3/8-inch spits because defendants did not modify the machines to include the shorter spits until months after plaintiff filed suit. Nevertheless, it is clear that the foregoing discussion relating to the product created with the 2-3/8-inch prongs applies as well to the product created with the shorter ones: The products created using the one-inch prongs neither literally infringe nor are equivalent to the product in claim 1 of the '374 patent.

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42. Defendants' Combined Brief in Reply to Plaintiff's Markman Brief, in Opposition to Plaintiff's Motion for Summary Judgment, and in Support of Their Cross-Motion for Summary Judgment, Docket Entry No. 50, p. 11 (citing Affidavit of Brian E. Hendrickson, at ¶¶ 4-5, Tab 2, Defendants' Appendix II, Docket Entry No. 51).

43. *Id.* (citing Affidavit of Brian E. Hendrickson, at ¶ 5, Tab 2, Defendants' Appendix II, Docket Entry No. 51).

Appendix B

IV. *Conclusions and Orders*

For the reasons discussed above, the court concludes that "support member" as used in claim 1 of the '374 patent is a spit (or pointed rod) that traverses the length of the spiral cut and helps the boneless meat product maintain its shape or integrity during slicing operations. The remainder of claim 1's terms are construed in accordance with Judge Werlein's construction of the same in *Logan Farms, Inc., et al. v. Honey Baked Ham L.P., MI, et al.*, H-01-1611.

Consistent with the court's analysis, plaintiff's Motion for Partial Summary Judgment of Patent Infringement (Docket Entry No. 44) is DENIED, and Defendants' Cross-Motion for Summary Judgment on Infringement (Docket Entry No. 49) is GRANTED.

APPENDIX C — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING DATED AND FILED FEBRUARY 22, 2007

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2006-1114

JAMES P. LOGAN, JR.,

Plaintiff-Appellant,

and

LOGAN FARMS, INC.,

Plaintiff,

v.

HORMEL FOODS, INC.,

Defendant-Appellee,

and

WAL-MART, INC.,

Defendant-Appellee.

ORDER

Before Lourie, Circuit Judge, Linn, Circuit Judge, and Moore, Circuit Judge.

A petition for rehearing having been filed by the Appellant,

Appendix C

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED.

The mandate of the court will issue on March 1, 2007.

FOR THE COURT,

s/ Jan Horbaly
Jan Horbaly
Clerk

Dated: 02/22/2007